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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,036	12/11/2000	Kenji Yamauchi	249331/98DIV	2508

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EXAMINER

LEUNG, QUYEN PHAN

ART UNIT	PAPER NUMBER
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2828

DATE MAILED: 10/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/733,036

Applicant(s)

YAMAUCHI

Examiner

Quyen P. Leung

Art Unit

2828

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 October 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-9, 21-33

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See attached response to arguments.


Quyen P. Leung
Primary Examiner
Art Unit: 2828

Continuation of 2. NOTE: While it is proposed that independent claim 1 be rewritten to further include the features of its dependent claim 4, that independent claim 21 include the features of dependent claim 24, and that independent claim 31 include features not previously considered with claim 31, the scope of the claims not depending on claim 4 or 24 and claims 31-33 have been narrowed, raising new issues that would require further consideration and/or search.

Response to Arguments

1. Applicant's arguments filed 10/2/02 have been fully considered but they are not persuasive. Applicant made the following arguments:

a. "A feature of the present invention, in a non-limiting embodiment as defined, for example, by independent claim 1 (and substantially similarly by independent claims 21 and 31), and as shown for example in Fig. 5, is that the first mark (e.g., reference numeral 19; all reference numerals used herein being solely for the Examiner's understanding and convenience and not for limiting the claims in any way) is constructed by a thin line formed on an upper portion of the active layer 11. With this first mark formed on an upper portion of the active layer 11, shifting amounts of the relative position of the positioning marks 15,16 to an active layer 11 is easily accomplished. Neither Sasaki or Tada teaches or suggests such features."

b. "Accordingly, although a first marker 5 and a second marker 14 are described in Sasaki, neither are formed on an upper portion of a laser output portion 6. Further Applicant notes that Fig. 1 of Sasaki discloses an electrode 4a, which is not a marker. Thus, Sasaki does not teach or suggest "*said first mark is constructed by a thin line formed on an upper portion of said active layer*", as defined by independent claim 1 (and similarly by independent claims 21 and 31)."

c. "Regarding the rejection of claims 1, 6-8, and 29-30 as being anticipated by Tada, fig. 3(c.) of Tada discloses markers..."

In response to arguments a-c above, it is noted that Applicant has proposed that independent claim 1 be rewritten to further include the features of its dependent claim 4, that independent claim 21 include the features of dependent claim 24, and that independent claim 31 include a new feature not previously considered with claim 31 or its dependent claims, that new feature being that of claim 4. So, while applicant's arguments relate to the proposed amended claims, the arguments relating to Tada are moot because Tada was not depended upon for the rejections of claims 4, 24 at the time the final rejection was made.

In further response to arguments a-b above, Examiner disagrees with Applicant that Sasaki does not teach the claimed features of claims 4 and 24 at the time the final rejection was made, because the claim language as written is broad enough to encompass the other embodiments disclosed by applicant, e.g. figures 3-4 and figures 6-7, as well as the teaching of Sasaki. Applicant's figures 3-4 and 6-7 show a thin-line mark(s) formed on an "upper portion" of the active layer, i.e. not in the same lateral plane as the active layer. Likewise, Sasaki's figures 1 and 2 show thin-line marks (5, 14) not in the same lateral plane as the laser output portion or active layer (6). As noted by applicant's comments above, the claim language is "non-limiting" to figure 5 of applicant's specification. So applicant's argument is not convincing against the Sasaki rejection.


Furthermore, in response to argument b above, Examiner disagrees that Sasaki's element 4a is not a marker, because it is made of the same metal

conductive film as Sasaki's other markers 5, 14, and also it "marks" where the projection part of the laser diode (1). So applicant's argument is not found convincing.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quyen P. Leung whose telephone number is (703) 308-0545. The examiner can normally be reached on 8:30-5:00, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Ip can be reached on (703) 308-3098. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7724 for regular communications and (703) 308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Quyen P. Leung
Primary Examiner
Art Unit 2828

QPL
October 15, 2002